UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,647	01/26/2004	Bao Tran	IPgineering-001	9095

31688   7590   03/06/2006

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

EXAMINER
SINGH, RACHNA

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/764,647	TRAN, BAO
	Examiner	**Art Unit**	
	Rachna Singh	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 January 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>26 January 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>01/30/06</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Application filed 01/26/04.

2.   Claims 1-21 are pending. Claims 1, 19, 20, and 21 are independent claims.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on 01/30/06 is being

considered by the examiner.

Claim Objections

4.   Claims are misnumbered. The claim listing is missing claim 11 and comprises

two "Claim 15". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   "Second Claim 15" is rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The claim recites "mapping intellectual

property for an industry covered by the patent or patent application". It is unclear what

the claim is intended to mean, as there is no description for this feature in the

Applicant's specification.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-7, 10, 12-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over <u>Gonzales</u>, US 2002/0161603 A1, 10/31/02 in view of <u>Sweet et al.</u>, US

6,567,799 B2, 05/20/03.

In reference to claims 1 and 19-21, Gonzales teaches an interactive publishing

system for providing content management. Gonzales teaches a browser-based

publishing tool allows a user to create a document that includes a hyperlink enabling a

person viewing the document to navigate from a first point in the document to a second

point in the document, or further to another document. See page 1, paragraph [0007].

Gonzales further teaches a web page (i.e. document) include areas designated to

contain content e.g., text and images, or to provide navigation bars (nav) from a

presently displayed page to another. These areas can comprise several regions. See

figure 2. A hyperlink, or link, is a text or image area on which a user can click to

connect to or reference another document or content component. A link can connect

two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3,

paragraphs [0045]-[0047] and figure 2. Compare to *"embedding one or more links in*

the first portion referencing one or more external documents" and "embedding

one or more links in the third portion referencing information contained in the

second portion".

Gonzales does not expressly teach the one or more external documents are

"viewable using a viewer application"; although he does teach viewing the documents

via a browser. Sweet teaches retrieving documents linked to an initial document.

Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to *"documents viewable using a viewer application"*. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 2, Gonzales does not teach the document is a PDF document residing in a PDF file; however Sweet does. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to *"documents viewable using a viewer application"*. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display

data to be stored as a single document, having a fixed page size. See columns 3-4 of

Sweet.

In reference to claim 3, Gonzales does not teach encapsulating one or more links

into a PDF file; however Sweet does. Sweet teaches the PDF document may have

hypertext links to web pages, as well as internal pages within the document. The link is

integrated into the PDF document and displayed by the PDF viewer. See column 8,

lines 42-50. It would have been obvious to a person of ordinary skill in the art at the

time of the invention to encapsulate the links into the PDF file because it allows a user

to link to a page within the PDF document. See column 8, lines 42-50.

In reference to claim 4, Gonzales does not teach the viewer application is a PDF

application; however, Sweet does. Sweet teaches in response to a request from a user,

a PDF viewer may retrieve from one or more web servers an initial document specified

by a URL and other documents which are linked to the initial document. See column 8,

lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines

26-50. Compare to *"documents viewable using a viewer application"*. It would

have been obvious to a person of ordinary skill in the art at the time of the invention to

provide a viewer application to view documents referenced in Gonzales' system

because it was desirable to provide a means to convert a semantic markup

representation of a document into a physical markup representation of the document

(i.e. PDF) as it provides a common and convenient way for display data to be stored as

a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 5, Gonzales does not teach retrieving one or more pages of

an external document referenced by a link and consolidating all pages into the external

document; however, Sweet does. Sweet teaches a web page integrator which is a part

of a PDF viewer. The PDF viewer may request the integrator to retrieve from one or

more web servers, an initial document specified by a URL supplied by the user or other

documents which are linked, directly or indirectly, to the initial document. When the

documents are retrieved, the web page integrator integrates them into a single PDF

document which is then displayed by the PDF viewer. See column 8, lines 26-41. It

would have been obvious to a person of ordinary skill in the art at the time of the

invention to consolidate all pages into the external document because it was desirable

to provide a means to convert a semantic markup representation of a document into a

physical markup representation of the document (i.e. PDF) as it provides a common and

convenient way for display data to be stored as a single document, having a fixed page

size. See columns 3-4 of Sweet.

In reference to claim 6, Gonzales further teaches a web page (i.e. document)

include areas designated to contain content e.g., text and images, or to provide

navigation bars (nav) from a presently displayed page to another. These areas can

comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on

which a user can click to connect to or reference another document or content

component. A link can connect two web pages, i.e., an internal link, or two websites,

i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither

Gonzales nor Sweet disclose the document comprises a patent or patent application

where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 7, Gonzales teaches a web page (i.e. document) includes areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a claim section; however, the claim section is merely a paragraph of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 10, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a the claim of a patent application and file history because a claim and file history are simply text.

In reference to claim 12, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither

Gonzales nor Sweet disclose the document comprises a patent or patent application

where the first portion is a prior art section, the second portion is a description section,

and the third section is a claim section; however, the prior art section, description and

claim sections are merely paragraphs of a document. As both Gonzales and Sweet

teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it

would have been obvious to a person of ordinary skill in the art at the time of the

invention to draft the document such that the text depicted a description of an invention,

a claim of a patent application, or listed prior art references because a description,

claim, and prior art are simply text.

In reference to claims 13-14, Gonzales teaches a database contains data relating

to articles and documents that are developed by the users of system over the Internet.

See pages 2, paragraph [0040] and page 3, paragraphs [0045].

In reference to first claim 15, Gonzales further teaches a web page (i.e.

document) include areas designated to contain content e.g., text and images, or to

provide navigation bars (nav) from a presently displayed page to another. These areas

can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area

on which a user can click to connect to or reference another document or content

component. A link can connect two web pages, i.e., an internal link, or two websites,

i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither

Gonzales nor Sweet disclose the document comprises a patent or patent application

where the first portion is a prior art section, the second portion is a description section,

and the third section is a claim section; however, the prior art section, description and

claim sections are merely paragraphs of a document. As both Gonzales and Sweet

teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it

would have been obvious to a person of ordinary skill in the art at the time of the

invention to draft the document such that the text depicted a description of an invention,

a claim of a patent application, or listed prior art references because a description,

claim, and prior art are simply text.

In reference to second claim 15, Gonzales teaches the document comprises text.

This text could be related to a patent application or patent. As both Gonzales and

Sweet teach that the documents comprise text (See page 3, paragraph [0046] of

Gonzales), it would have been obvious to a person of ordinary skill in the art at the time

of the invention to draft the document such that the text depicted a description of an

invention, a claim of a patent application, or listed prior art references because a

description, claim, and prior art are simply text.

8.   Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2,

05/20/03, as applied to claim 6 above, and further in view of Fogel et al., US

2004/0059994, 03/25/04 (filed 12/02/02).

In reference to claims 8-9, Gonzales/Sweet do not teach visualizing the claims in

a tree view or drilling down details of each claim in the tree view; however Fogel does.

Fogel teaches a method of checking semantic and syntactical correctness of claims in a

claim tree format. The dependencies tree for each claim is built with at least one

independent claim. See abstract and page 8. It would have been obvious to a person

of ordinary skill in the art at the time of the invention to represent patent claims in a tree view as it depicts the relationships among independent and dependent claims. See page 5, paragraph [0229].

9.   Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 1 above, and further in view of Mahoney et al., US 5,999,664, 12/07/99.

In reference to claims 16-17, Gonzales/Sweet do not disclose using OCR from an image of the page and associating text with the corresponding location of the text in the image; however, Mahoney does. Mahoney teaches it was well known at the time of the invention to utilize OCR for search and retrieval of a document image. OCR distinguishes each bitmap of a character from its neighbor, analyzes the appearance, and distinguishes it from other characters in a predetermined set of characters. See page 3, lines5-51. Mahoney further teaches scanned images may be represented as PDF documents. See column 1, lines 34-40.   It would have been obvious to a person of ordinary skill in the art at the time of the invention to enable searching a document using OCR in a PDF document as it was desirable at the time of the invention to search for a document stored in a large database particularly hardcopy documents that are scanned as images having no structural definition as it would not be perceivable by a computer, thus there was a need to analyze image data and pixels to help identify a document stored in a large corpus of documents. See columns 1-2 of Mahoney.

10.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2,

05/20/03, as applied to claim 1 above, and further in view of Bargeron et al., US

2004/0205542 A1, 10/14/04 (filed 09/07/01).

In reference to claim 18, Gonzales/Sweet do not teach saving user annotations in

the document; however, Bargeron does. Bargeron teaches the anchoring of

annotations to content. On page 1, paragraph [0005], Bargeron discloses an annotation

is associated with a particular portion of content. It would have been obvious to a

person of ordinary skill in the art at the time of the invention to incorporate Bargeron's

annotation in the document in the system of Gonzales/Sweet as it was desirable to

provide a means to preserve the annotations in a digital document because digital

documents are easily and frequently altered, thereby changing the portion of the

document to which the annotation corresponds. It would thus be beneficial to provide a

way to improve the manner in which annotations are associated with portions of

documents so that the annotations are still associated with the correct portion of the

document despite alterations to the underlying content.   See page 1, paragraph [0004].

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Carr, L.a. W. Hall, S. Hitchcock, "Link Services or Link Agents?", Conference on
Hypertext and Hypermedia, Proceedings of the ninth ACM conference on Hypertext and
hypermedia : links, objects, time and space---structure in hypermedia systems: links,
objects, time and space---structure in hypermedia systems; Pittsburgh, Pennsylvania,
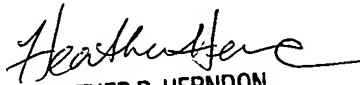United States; Pages: 113 – 122; Year of Publication: 1998; ISBN:0-89791-972-6.

<u>Bates et al.</u>	US 2003/0196172
<u>Teplitsky et al.</u>	US 2005/0138004
<u>Stern et al.</u>	US 2002/0052928
<u>Shaw et al.</u>	US 6,151,598
<u>Sweet et al.</u>	US 2002/0073074

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS
02/22/06

HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100